

Case 1005-U.S.**S.N. 101,614,207****Attorney Docket – TKM-1005****REMARKS**

Reconsideration of the requirement to restrict in the June 22, 2006 Office Action is requested on the ground that the requirement is not in accordance with the Rules of Practice and the MPEP.

We are well aware of 37 CFR 1.142. Requirement for Restriction and specifically section (a).

“(a) If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as ...). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action.”

All practitioners, including the Examiner and the undersigned, know that the decades old policy of the Office is to require a restriction before the first Office action. The question then becomes, under what circumstances can a requirement to restrict be issued by the Office after a first Office action?

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The only recognized circumstance for requiring restriction after a first Office action we are aware of is found in 37 CFR 1.145, **Subsequent Presentations of Claims for Different Invention.**

“If, after an Office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed ...” (emphasis ours)

Here, applicant has not presented any “claims directed to an invention distinct from and independent of the invention previously claimed”, indeed, applicant has only attended to the technical criticisms and objections pointed out by the Examiner on pages 2 and 3 of the text portion of the March 24, 2005, Office action. The substance of all preambles and introductory phrases of all the original claims have been substantively repeated. As a matter of fact, the only claim “change” was to cancel original claim 7 which was a dependent claim.

The Manual of Patent Examining Procedure supports the above Rules. MPEP Sec. 811.03 recognizes that a requirement to restrict may be made after the first Office Action, which is consistent with the second sentence of Rule 142(a), but only in a special circumstance, not present here:

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Where a requirement to restrict is made and withdrawn, because it was improper, when it becomes proper at a later stage of the prosecution, restriction may again be required.

That language, though consistent with the second sentence of 1.142(a) as it should be, does not apply here since there was no requirement to restrict in the March 24, 2005, Office Action followed by a withdrawal thereof; rather the wording and scope of the claims has been substantively unchanged from the filing date.

We also note MPEP 818.01 which is straightforward and unambiguous and which applies to this situation:

MPEP 818.01 Election Fixed by Action on Claims

Election becomes fixed when the claims in an application have received an action on their merits by the Office.

In summary there is no statutory rule or practice basis for issuing an initial requirement to restrict the original claims three years after filing and 15 months after the first Office Action in which all original claims received an action on their merits.

Reconsideration of the June 27, 2006 requirement to restrict and withdrawal is therefore proper and respectfully requested.

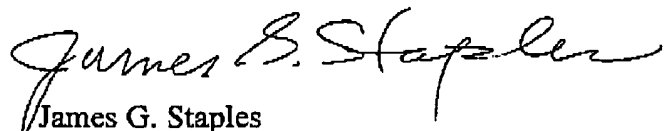
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In order to avoid any issue as to sufficiency of response, but without conceding the necessity of doing so, applicant hereby elects the claims of Group I, namely 1-6, 8-14 and 17-20.

Reconsideration and withdrawal of the requirement to restrict, and action on the merits of all claims as amended on July 18, 2005, is respectfully requested.

Respectfully submitted,

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